



ATTACHMENT A Remarks

In response to the Office Action mailed on February 24, 2005, reconsideration of the rejection of the claims is respectfully requested.

A. Rejection of Claims 1-2 and 4-8 Under 35 U.S.C. § 101

Claims 1-2 and 4-8 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter falling outside the technological arts.

Amended independent claim 1 now incorporates the limitation of prior dependent claim 3, namely that the list of configuration choices is presented in a graphical user interface. Thus, amended independent claim 1 now clearly falls within the technological arts.

Claim 3 has been incorporated in claim 1. Thus, claim 3 has been canceled.

Claims 2 and 4-8 depend from claim 1. Accordingly, it is respectfully suggested that the rejection of claims 1-2 and 4-8 under 35 U.S.C. § 101 can be properly withdrawn.

B. Rejection of Claims 25, 27 and 29 Under 35 U.S.C. § 112

Claims 25, 27 and 29 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, claims 25, 27 and 29 recite the limitation, "said description is of a function of the particular system configuration rather than of a function of an individual element of the particular system," and it is contended in the Office Action that there does not appear to be a written description of this claim limitation. Further, it is contended that the originally filed

specification, at page 3, line 29 – page 4, line 2, “discloses that said function is capable of being implemented by a system configuration 240 or may be by a component.”

This rejection is respectfully traversed. The Examiner admits that the specification states that the “function” is capable of being implemented by the system configuration 240 but basically contends that an alternative embodiment (“or may be by a component”) is also described. It is respectfully submitted that the mere fact that a different, “component” embodiment is also disclosed does not mean that there is no written description of the first embodiment. Moreover, it is clear that, in the first embodiment, the description is a function of the particular system configuration rather than of a function of an individual element of the particular system, as claimed. The second, “component” embodiment was never claimed and to the extent that a portion of the paragraph beginning on page 3, line 24 of the specification is confusing or otherwise unclear, one sentence in this paragraph has been deleted so that this paragraph is consistent with the original claims and the remainder of the specification, as well as with claims 25, 27 and 29.

It is now clear that:

- the browsing interface may receive a system configuration selection based on a combination of system elements selected from the list of configuration choices 230; and
- the relational database may analyze the system configuration selection and provide a description of a function capable of being implemented with the system configuration selection 240.

Thus, “the description is of a function of the particular system configuration rather than of a function of an individual element of the particular system”, as claimed in claims

25, 27 and 29, and supported by at least the paragraph beginning on page 3, line 24 of the specification. Thus, it is respectfully submitted that the rejection of claims 25, 27 and 29 under 35 U.S.C. § 112, first paragraph, can be properly withdrawn.

C. Rejection of Claims 1 - 4, 9 - 13 and 17 - 21 Under 35 U.S.C. § 102

Claims 1 - 4, 9 - 13 and 17 - 21 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Henson (U.S. Patent 6,167,383). This rejection is respectfully traversed.

Independent claims 1, 9 and 17 recite “receiving a system configuration selection including a combination of system elements” and “providing a description of a function capable of being implemented with said system configuration selection.”

It is alleged in the Office Action that Henson teaches a method for configuring a build-to-order system including providing a description of a function capable of being implemented with a system configuration selection based on a combination of system elements. Col. 6, lines 18 – 43 (describing FIGS. 3A, 3B and 3C), and FIG. 5 and col. 9, lines 9 – 25 are cited in support. It is respectfully suggested that this is a misinterpretation of the actual teachings of the Henson reference.

Lines 18 – 43 of col. 6 (describing FIGS. 3A, 3B and 3C) describe an example of a system configuration options screen that provides descriptions of functions capable of being implemented with individual classes of system elements, such as memory, hard drives, and monitors. However, nowhere in col. 6, lines 18 – 43 or in FIGS. 3A, 3B or 3C is it taught or suggested to provide a description of a function capable of being implemented with the system configuration selection, including a combination of system elements, as recited in independent claims 1, 9 and 17. Likewise, FIG. 5 and col. 9,

lines 9 – 25, describe providing descriptions of individual classes of system elements (e.g. memory, hard drives, monitors, and video cards), but fail to teach or even suggest providing a description of a function capable of being implemented with the combination of system elements that comprise the system configuration selection.

At best, Henson describes a “merchandising module” which provides merchandising information or messaging of options recommended to be selected in a particular configuration, including, for example, which options may be better than others (see col. 6, lines 39 – 43). However, nowhere is it taught or suggested that the merchandising module provides a description of a function capable of being implemented with the combination of system elements that comprise the system configuration selection, as in independent claims 1, 9 and 17.

In fact, the examples provided in FIGS. 3A, 3B, 3C and 5 of Henson appear to contain only merchandising information for broad classes of system elements, and do not even attempt to provide functions for individual components within those classes. For example, a single description is provided for “Hard Drives” as “A larger hard drive provides more storage for your operating system, Internet files, applications, graphics and scanned images! Dell offers EIDE hard drives up to 16.8 GB.” Also, a single description is provided for “Monitor” as “Upgrading to a larger monitor is surprisingly affordable. Dell’s line-up of exceptional monitors can deliver enhanced resolution and refresh rates, crisp, vibrant imaging and amazing color depth.” See FIGS. 3A and 5.

While independent claims 1, 9 and 17 clearly distinguish over the Henson based solely on the language of the claims, it is believed that a non-limiting example of the claimed invention may serve to further highlight the distinction. FIG. 5A of the instant

application shows a display of a build-to-order computer system according to one embodiment of the invention, wherein a lower end model of a printer and a lower end model of a digital camera have been selected. The “description of a function capable of being implemented with the system configuration selection” in this example is: “Take good quality pictures to e-mail to friends. Print color images at 1 page per minute.”

FIG. 5B shows a display of an alternative system where the description of the function capable of being implemented with the system is: “Take high quality (2 mega pixel) pictures to e-mail to friends. Record 15 second video clips. Listen to music on your camera. Print photo quality color images at 10 pages per minute.” There is simply nothing like this disclosed in Henson and, in particular, nowhere does Henson teach or suggest providing a description of a function capable of being implemented with a selected system configuration combination of system elements, as claimed. In response to the statement made in the Office Action regarding the examples cited in the previous response, it should be understood that applicant is not arguing that the examples discussed above are being specifically claimed or that it is only these specific examples that patentably distinguish from Henson, but rather that the quoted claim language itself patentably defines over Hanson.

Claims 2 - 4, 8, 10 - 12, 16, 18 - 20, 24 – 25, 27 and 29 depend from claims 1, 9 and 17 and are thus patentable for at least the reasons set forth above in support of the patentability of the independent claims. Accordingly, it is respectfully submitted that the rejection of claims 1 - 4, 8 – 12, 16-20, 25 – 25, 27 and 29 under 35 U.S.C. § 102(e) as being anticipated by Henson can be properly withdrawn.

D. Rejection of Claims 5 - 7, 13 - 15 and 21 - 23 Under 35 U.S.C. § 103

Claims 5 - 7, 13 - 15 and 21 - 23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson in view of Tuzhilin (U.S. Patent 6,236,978). This rejection is respectfully traversed.

Claims 5 – 7, 13 – 15, and 21 – 23 depend from independent claims 1, 9 and 17. It is respectfully submitted that Tuzhilin fails to make up the deficiencies of Henson as a reference against the claims and, thus, that neither Henson nor Tuzhilin, however combined or taken together, teach or suggest providing a description of a function capable of being implemented with a system configuration selection. Accordingly, for at least the reasons discussed above, it is respectfully suggested that the rejection claims 5-7, 13-15 and 21-23 can also be properly withdrawn.

E. Rejection of Claims 26, 28 and 30 Under 35 U.S.C. § 103

Claims 26, 28 and 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Henson in view of Tuzhilin and further in view of Roberts et al. (U.S. Patent 6,101,486). This rejection is respectfully traversed.

Claims 26, 28 and 30 depend from independent claims 1, 9 and 17. It is respectfully submitted that the Roberts et al. patent fails to make up the deficiencies of Henson and Tuzhilin as references against the claims and, thus, that neither Henson, Tuzhilin, nor Roberts et al. however combined, teach or suggest providing a description of a function capable of being implemented with a system configuration selection. Accordingly, for at least the reasons discussed above, it is respectfully suggested that the rejection claims 26, 28 and 30 can also be properly withdrawn.

F. Prior Art Made of Record and Not Relied On

The prior art made of record but not relied on in the instant Office Action has been reviewed. However, none of the references appears to be any more relevant than the references discussed herein. Thus, further discussion of the additional references does not appear warranted at this time.

Conclusion

It is respectfully urged that the instant application, as amended, is now in condition for allowance. However, if the Examiner believes that there are unresolved issues, the Examiner is respectfully invited to contact applicant's attorney to discuss these issues.

END REMARKS